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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,085	03/26/2001	Arthur Schaffer	U 013220-5	3061

140 7590 03/21/2003

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NEW YORK, NY 10023

EXAMINER

FOX, DAVID T

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 03/21/2003

Handwritten signature/initials

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,085

Applicant(s)

Schaffer et al

Examiner

FOX

Group Art Unit

1638

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 1/6/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-3, 5-8, 17-19, 23, 25, 27 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 2, 5-8, 17-19, 23, 25, 27 is/are rejected.
- ☒ Claim(s) 3 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☒ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The amendments of 6 January 2003 and accompanying substitute specification have been entered. Claims 1-3, 5-8, 17-19, 23, 25 and 27 are pending.

The amendments of 6 January 2003 have overcome the outstanding rejections under 35 USC 112, second paragraph; 35 USC 102 and 103.

Claims 1-2, 5-8, 17-19, 23, 25 and 27 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as stated on pages 3-5 of the last Office action for claims 1-10, 17-19, 23, 25 and 27.

Claims 1-2, 5-8, 17-19, 23, 25 and 27 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for claims limited to a method for introgressing a gene encoding the large subunit of ADPGPPase from *Lycopersicon hirsutum*, and the use of PCR markers to identify the presence of said *L. hirsutum* gene, does not reasonably provide enablement for claims broadly drawn to any gene from *L. hirsutum* which encodes any product that somehow increases ADPGPPase activity, or for the use of any type of molecular marker to identify said gene. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention

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commensurate in scope with these claims, as stated in the last Office action on pages 5-8 for claims 1-10, 17-19, 23, 25 and 27.

Claim 7 is included in these rejections because it encompasses non-exemplified types of molecular markers of a multitude of sequences, such as RFLPs, SSRs, isozymes, etc.

The amended claims and dependents are deemed free of the prior art, as stated in the last Office action on page 11 for claims 3-6, 8 and 10.

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

No claim is allowed.

Applicants' arguments filed 6 January 2003, insofar as they pertain to the rejections above, have been fully considered but they are not persuasive.

Applicants urge that the amendments have overcome all rejections including those made under 35 USC 112, first paragraph. The Examiner maintains that the amendment of claim 1 to recite that *Lycopersicon hirsutum* is the source of the introgressed gene *begins* to address the issues raised in the outstanding rejections, as stated in the Interview Summary (paper no. 16). However, claims broadly drawn to any gene from *L. hirsutum* encoding any product which somehow increases the activity of ADPGPPase remain inadequately described, as do a multitude of non-exemplified molecular markers, as stated previously. Furthermore, the unpredictability set forth in the last Office action renders the broad claims non-enabled, particularly in view of the fact

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that Applicants were unable to obtain an increase in ADPGPPase activity when even the *L. hirsutum* gene encoding the *small* subunit of ADPGPPase was introgressed, as stated in the last Office action.

The following amendments would result in allowance of the claims:

Combine claims 1 and 3.

Amend claim 5 to insert --PCR-- before “molecular” in line 2, and replace “gene” in line 2 with --allele--.

Cancel claims 2-3 and 6-7.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

March 18, 2003

DAVID T. FOX
PRIMARY EXAMINER
GROUP 1638

A large, stylized handwritten signature in black ink, likely belonging to David T. Fox, is written over the printed name and group number.